

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 27-30 are canceled without prejudice. New claims 31-34 are added. Claims 1-26 and 31-34 are pending in this application.

Missing Reference Cite

In the February 25, 2003 Final Office Action, a rejection was made based on U.S. Patent No. 4,644,493 to Chandra. The February 25, 2003 Final Office Action did not include a Notice of References Cited (PTO-892) citing the 4,644,493 patent, and Applicant respectfully requests that the Patent Office issue a Notice of References Cited Form PTO-892 citing the 4,644,493 patent.

35 U.S.C. § 132

In the February 25, 2003 Final Office Action, it was asserted that the amendment filed January 24, 2003 introduced new matter into the disclosure. The amendment filed January 24, 2003 was objected to under 35 U.S.C. §132, new claims 24-26, 29, and 30 were objected to under 35 U.S.C. §132, and Applicant's arguments filed January 24, 2003 regarding claims 1, 2, 9, and 15 were indicated as not being persuasive because the amended limitations in claims 1, 2, 9, and 15 are not in the original disclosure.

In the May 6, 2003 Advisory Action, the new matter rejection of claim 2 was withdrawn, however the new matter rejection of claims 1, 9, 15, and 24 was maintained. Applicant respectfully disagrees with these assertions that new matter was introduced in the amendment filed January 24, 2003.

As part of this amendment, claims 29 and 30 have been canceled without prejudice in order to advance prosecution of the remaining claims and to reduce the number of issues for consideration. The cancellation of claims 29 and 30 is not intended to be, and should not be interpreted as, Applicant agreeing with the rejection of claims 29 and 30.

With respect to claims 1, 9, 15, and 24, in the May 6, 2003 Advisory Action, on page 2, it was asserted in response to Applicant's April 25, 2003 response, that:

Applicant's argument that claims 1, 9, 15, and 24 do not include new matter is not persuasive because the cited portion of the specification does not include the amended limitation that the trigger file consist of only content other than a decryption key. The cited portion merely suggests that the trigger file be a previous software module of another file suitable for indicating that a computer is authorized for having software module installed.

Applicant respectfully disagrees with this assertion, and respectfully submits that the amendment filed January 24, 2003 does not introduce new matter.

The portion of Applicant's specification cited in the April 25, 2003 response states: "A trigger file may be a previous version of software module 225 or may be any file suitable for indicating that computer 20 is authorized for having software module 225 installed." In the Advisory Action, it is asserted that "The cited portion merely suggests that the trigger file be a previous software module of another file suitable for indicating that a computer is authorized for having software module installed" (see, Advisory Action, p. 2). This assertion in the Advisory Action ignores part of this cited portion. That is, this assertion in the Advisory Action ignores the language **"or may be any file suitable for indicating that computer 20 is authorized for having software module 225 installed."** As

the first part of the cited portion states that a trigger file may be a previous version of software module 225, this latter part of the cited portion clearly is not limited to being a trigger file that is a previous version of software module 225 as asserted in the Advisory Action. As this cited portion states that the trigger file may be a previous version of software module 225 or may be any file suitable for indicating that computer 20 is authorized for having software module 225 installed, this portion clearly indicates that the trigger file could be any file, and is not limited to being a previous version of software module 225.

Furthermore, Applicant's specification describes one embodiment of a database 220 of an installation module 202 with reference to Figure 3. Applicant's specification includes, at page 13, lines 14-20 (emphasis added):

Each row of database 220 includes an identifier 302 that is used to determine whether the corresponding trigger file is present on computer 20. In one embodiment, identifier 302 is a first cryptographic hash value generated by hashing the trigger file with a first hash algorithm. Each row further includes a key 304 that is used to decrypt software module 225 when the trigger file is present.

Thus, it can be clearly seen that the embodiment described in this portion of Applicant's specification uses a key that is in the database of the installation module to decrypt the encrypted software module 225. Thus, this portion at page 13, lines 14-20, clearly describes that the decryption key for decrypting the encrypted software module is not in the trigger file.

As Applicant's specification clearly describes that the trigger file "may be any file suitable for indicating that computer 20 is authorized for having software module 225 installed", and clearly describes at least one embodiment where the decryption key for decrypting the encrypted software module is not in the trigger

file, Applicant respectfully submits that Applicant's specification clearly provides support for the trigger file including content other than a decryption key for decrypting the encrypted software module.

For at least these reasons, Applicant respectfully submits that the amendment filed January 24, 2003 did not introduce new matter into the disclosure, and Applicant respectfully requests that the §132 objections be withdrawn.

35 U.S.C. § 112

Claim 28 stands rejected under 35 U.S.C. §112, second paragraph. In the February 25, 2003 Final Office Action, it was asserted that "Domestic strength cryptography is not a specific enough measure of cryptography strength." Applicant respectfully disagrees with this assertion. However, in order to advance prosecution of the remaining claims and to reduce the number of issues for consideration, Applicant has canceled claim 28 without prejudice. The cancellation of claim 28 is not intended to be, and should not be interpreted as, Applicant agreeing with the rejection of claim 28.

35 U.S.C. § 102

Claim 27 stands rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 4,644,493 to Chandra (hereinafter "Chandra"). Applicant respectfully disagrees with this rejection and submits that claim 27 is not anticipated by Chandra. However, in order to advance prosecution of the remaining claims and to reduce the number of issues for consideration, Applicant

has canceled claim 27 without prejudice. The cancellation of claim 27 is not intended to be, and should not be interpreted as, Applicant agreeing with the rejection of claim 27.

Claims 1, 8-11, 14-16, 19, 20, 22, and 23 stand rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,075,862 to Yoshida et al. (hereinafter "Yoshida"). In the February 25, 2003 Final Office Action Applicant's arguments filed January 24, 2003 regarding claims 1, 2, 9, and 15 were indicated as not being persuasive because the amended limitations in claims 1, 2, 9, and 15 are not in the original disclosure. As discussed above, Applicant respectfully submits that no new matter was added as part of the January 24, 2003 amendment, and thus that claims 1, 2, 9, and 15, as amended, are allowable over the art of record for at least the reasons discussed in the January 24, 2003 amendment.

Given that claim 8 depends from claim 1, claims 10, 11, and 14 depend from claim 9, and claims 16, 19, 20, 22, and 23 depend from claim 15, Applicant respectfully submits that claims 8, 10, 11, 14, 16, 19, 20, 22, and 23 are allowable over the art of record at least because of their dependency on their respective base claims.

Applicant respectfully requests that the §102 rejections be withdrawn.

35 U.S.C. § 103

Claims 4, 6, 12, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshida in view of Davis and further in view of U.S. Patent No. 5,825,890 to Elgamal (hereinafter "Elgamal"). Claims 7 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshida in view of U.S.

Patent No. 6,058,478 to Davis (hereinafter "Davis"). Claims 2, 3, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshida in view of U.S. Patent No. 5,563,950 to Easter (hereinafter "Easter"). Claims 5 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshida in view of Easter and further in view of U.S. Patent No. 5,199,073 to Scott (hereinafter "Scott"). Applicant respectfully submits that claims 4, 6, 12, 21, 7, 13, 2, 3, 18, 5, and 17 are allowable over the art of record.

With respect to claim 2, Applicant respectfully submits that even if Yoshida and Easter are combined, the combination does not disclose or suggest the installation module of claim 2. The February 25, 2003 Office Action states, at ¶ 12, p. 8, that "Yoshida does not describe storing or retrieving the decryption key from a database. Easter discloses a public key that is obtainable from a database (Col. 1, lines 55-58)." Additionally, at ¶ 12, p. 7, the February 25, 2003 Office Action states that "Yoshida discloses a decryption key management scheme for software distribution that allows the re-installation of software without re-acquisition of the decryption key (trigger file) from the software vendor." Thus, in the February 25, 2003 Office Action, the decryption key of Yoshida is asserted as being equivalent to the "trigger file" of claim 2.

Claim 2 recites:

An installation module comprising:
an encrypted software module;
an executive for decrypting the encrypted software module
when at least one of a set of trigger files is stored on a computing
system; and
a database for identifying the trigger files.

Thus, in claim 2, the database for identifying the trigger files is **part of the same installation module** as the encrypted software module and the executive. In order for the decryption key of Yoshida to be equivalent to the trigger file of claim 2, using the language of claim 2 but replacing "trigger file" with "decryption key", the combination of Yoshida and Easter would have to disclose that the installation module includes an encrypted software module as well as a database for identifying decryption keys. As discussed in additional detail below, Applicant respectfully submits that nothing in Yoshida, Easter, or the combination thereof discloses or suggests such an installation module.

Yoshida is directed to a decryption key management scheme for a software distribution system (see, col. 1, lines 1-9). The software ID and decryption key for software are stored into a decryption key memory unit on a computer's hard disk drive (see, col. 6, lines 1-14, and Fig. 1). Yoshida further discloses that when re-installing the software that was already installed once, it is possible to decrypt the encrypted software content immediately by utilizing the decryption key stored in the decryption key memory unit (see, col. 7, lines 13-20). When the software is installed for the first time, the decryption key will be automatically acquired from the software vendor (see, col. 7, lines 13-20). The decryption key is acquired from the software vendor through a communication network in exchange for payment of a software usage charge (see, col. 6, lines 41-53).

Thus, Yoshida discloses obtaining the decryption key from the hard disk of the computer on which the software is to be installed or from the software vendor through a communication network in exchange for payment of a software usage charge. Neither of these methods of obtaining the decryption key in Yoshida

discloses or suggests an installation module that includes an encrypted software module as well as a database for identifying decryption keys.

Easter, on the other hand, discloses system and methods for encrypting data using public key cryptography (see, col. 1, lines 1-13). Easter discloses that each user has both an individual public key and an individual private key (see, col. 1, lines 53-55). The public key is obtainable from a common database of every user and their respective public key, and the private keys are conventionally entered in the local system by the user through manual entry or insertion of a removable data card with the private key stored thereon (see, col. 1, lines 55-61).

Easter merely refers to a public key being obtainable from a common database of every user and their respective public key, or a private key being entered through manual entry or insertion of a removable data card. Nothing in this discussion in Easter discloses or suggests a database for identifying decryption keys being included in an installation module that also includes an encrypted software module.

Thus, it can readily be seen that neither Yoshida nor Easter discloses or suggests an installation module that includes an encrypted software module as well as a database for identifying decryption keys. As neither Yoshida nor Easter discloses or suggests such a database being included in the same installation module as an encrypted software module, the combination of Yoshida and Easter also cannot disclose or suggest such a database being included in the same installation module as an encrypted software module. Thus, even if the "trigger file" of claim 2 and the decryption key of Yoshida were equivalent, there is still no disclosure or suggestion of the database for identifying the trigger files being part

of the same installation module as the encrypted software module and the executive as recited in claim 2.

For at least these reasons, Applicant respectfully submits that claim 2 is allowable over Yoshida in view of Easter.

With respect to claim 3, claim 3 depends from claim 2 and Applicant respectfully submits that claim 3 is allowable over Yoshida in view of Easter at least because of its dependency on claim 2.

With respect to claim 4, claim 4 depends from claim 2. Applicant respectfully submits that Davis is not cited as disclosing, and does not disclose, a database for identifying the trigger files is part of the same installation module as the encrypted software module and the executive as recited in claim 2. Thus, Applicant respectfully submits that Davis does not overcome the deficiencies of Yoshida, and that claim 4 is allowable over Yoshida in view of Davis at least because of its dependency on claim 2.

With respect to claim 5, claim 5 depends from claim 2. Applicant respectfully submits that Scott is not cited as disclosing, and does not disclose, a database for identifying the trigger files is part of the same installation module as the encrypted software module and the executive as recited in claim 2. Thus, Applicant respectfully submits that Scott does not overcome the deficiencies of Yoshida and Easter, and that claim 5 is allowable over Yoshida in view of Easter and Scott at least because of its dependency on claim 2.

With respect to claim 18, Applicant respectfully submits that, similar to the discussion above regarding claim 2, Yoshida in view of Easter does not disclose or suggest wherein the decrypting includes retrieving a cryptographic key from a

database of an installation module that includes the encrypted software module as recited in amended claim 18. For at least these reasons, Applicant respectfully submits that amended claim 18 is allowable over Yoshida in view of Easter.

With respect to claims 6 and 7, claims 6 and 7 depend from claim 1. As discussed above, Applicant respectfully submits that no new matter was added as part of the January 24, 2003 amendment and that claim 1 is allowable over the art of record for at least the reasons discussed in the January 24, 2003 amendment. Given their dependency on claim 1, Applicant respectfully submits that, analogous to the discussion in the January 24, 2003 amendment, claims 6 and 7 are allowable over the art of record at least because of their dependency on claim 1.

With respect to claims 12 and 13, claims 12 and 13 depend from claim 9. As discussed above, Applicant respectfully submits that no new matter was added as part of the January 24, 2003 amendment and that claim 9 is allowable over the art of record for at least the reasons discussed in the January 24, 2003 amendment. Given their dependency on claim 9, Applicant respectfully submits that, analogous to the discussion in the January 24, 2003 amendment, claims 12 and 13 are allowable over the art of record at least because of their dependency on claim 9.

With respect to claims 17 and 21, claims 17 and 21 depend from claim 15. As discussed above, Applicant respectfully submits that no new matter was added as part of the January 24, 2003 amendment and that claim 15 is allowable over the art of record for at least the reasons discussed in the January 24, 2003 amendment. Given their dependency on claim 15, Applicant respectfully submits that, analogous to the discussion in the January 24, 2003 amendment, claims 17 and 21

are allowable over the art of record at least because of their dependency on claim 15.

Applicant respectfully requests that the §103 rejections be withdrawn.

New Claims

New claims 31-34 are added.

With respect to new claim 31, Applicant respectfully submits that the cited references do not disclose or suggest a method comprising: checking whether at least one of a set of one or more trigger files is stored on a computer; determining, based on the checking, which of multiple versions of a software module to install on the computer, wherein a first version of the multiple versions has greater than a threshold strength encryption, and wherein a second version of the multiple versions has not greater than the threshold strength encryption; wherein the determining comprises determining that the first version is to be installed on the computer if at least one of the set of one or more trigger files is stored on the computer, and that the second version is to be installed on the computer if none of the set of one or more trigger files is stored on the computer; wherein if the first version is to be installed on the computer then decrypting the first version and installing the decrypted first version; and wherein if the second version is to be installed on the computer then installing the second version, as recited in new claim 31. For at least these reasons, Applicant respectfully submits that new claim 31 is allowable over the cited references.

With respect to new claim 32, new claim 32 depends from new claim 31 and Applicant respectfully submits that new claim 32 is allowable over the cited

references at least because of its dependency on claim 31. Furthermore, Applicant respectfully submits that the cited references do not disclose or suggest a method as recited in claim 31, wherein the threshold strength encryption comprises 56-bit encryption, as recited in new claim 32. For at least these reasons, Applicant respectfully submits that new claim 32 is allowable over the cited references.

With respect to new claim 33, new claim 33 depends from new claim 31 and Applicant respectfully submits that new claim 33 is allowable over the cited references at least because of its dependency on claim 31. Furthermore, Applicant respectfully submits that the cited references do not disclose or suggest a method as recited in claim 31, wherein one of the set of one or more trigger files comprises a prior version of the software module, as recited in new claim 33. For at least these reasons, Applicant respectfully submits that new claim 33 is allowable over the cited references.

With respect to new claim 34, new claim 34 depends from new claim 31 and Applicant respectfully submits that new claim 34 is allowable over the cited references at least because of its dependency on claim 31. Furthermore, Applicant respectfully submits that the cited references do not disclose or suggest a method as recited in claim 31, wherein each trigger file of the set of one or more trigger files consists of only data other than a decryption key for decrypting the encrypted restricted software module, Applicant respectfully submits that new claim 34 is allowable over the cited references.

Conclusion

Claims 1-26 and 31-34 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

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